Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WINSTON A. ANDREWS, GLORIA R. DUMLAO
and TERRY R. KNAPP

Appeal No. 1998-2806
Application No. 08/459,721

ON BRIEF

Before METZ, FRANKFORT, and ROBINSON, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 18 through 26, which are all of the claims remaining in the application. Claims 1 through 17 and 27 through 36 have been canceled.

Appellants' invention relates generally to surgical implants or prostheses (e.g., breast implants), and more particularly to 1) a filler material for implants comprising a

flexible shell enclosing a filler material and 2) a method for preparing a synthetic triglyceride filler material.

Independent claim 18 is

representative of the subject matter before us on appeal and a copy of that claim can be found in Appendix A of appellants' brief.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Destouet et al. (Destouet) 4,995,882 Feb. 26, 1991

Claims 18 through 20 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by an admission in appellants' specification (page 6, lines 4-20).

Claims 21 through 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admission in appellants' specification (page 6, lines 4-20) in view of Destouet.[1]

[1] On page 6 of the examiner's answer, the examiner has indicated withdrawal of the rejection of claims 21 and 24 under 35 U.S.C. § 112, second paragraph, that was part of the final rejection (Paper No. 11).

Rather than reiterate the examiner's full commentary on the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 17, mailed November

14, 1997) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (Paper No. 16, filed July 21, 1997) and reply brief (Paper No. 18, filed January 16, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art Destouet reference, to the purported admission in appellants' specification, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Both of the examiner's prior art rejections of the appealed claims are based on the determination by the examiner that the entirety of the subject matter set forth on page 6, lines 4 through 20 of the specification of appellants' application constitutes an admission on the appellants' part that all of such subject matter is prior art. Like appellants, after having reviewed the statements made at page

6, lines 4 through 20 of the specification, it is our view that the examiner has misconstrued the extent of appellants' admission and instead impermissibly relied upon appellants' own teachings regarding the invention to

provide the evidentiary basis for the rejection of claims 18 through 20 under 35 U.S.C. § 102(b) and of claims 21 through 26 under 35 U.S.C. § 103.

While appellants do concede that triglyceride compositions like those of the invention "can be prepared using standard methods known to those skilled in the art such as by reacting pure, fully saturated fatty acids of the desired carbon length with purified glycerol in an esterification reaction" and that the resulting triglycerides are purified from the reaction mixture by known techniques to provide a pure, non-contaminated triglyceride, they have in no way admitted that changing the viscosity to be that which is disclosed and claimed in the present application is known in the art to be achievable by any such method, or more specifically that the claimed step of formulating a synthetic triglyceride filler material composition comprised of alkyl chains of varying length in proportional amounts sufficient to yield a filler material of a selected viscosity was known in the art. Since the examiner has improperly relied upon the disclosure of the present application and appellants' own

teachings in concluding that the method as set forth in claims 18 through 20 is anticipated and that the subject matter of claims 21 through 26 would have been obvious,

it follows that we will not sustain the examiner's rejection of claims 18 through 20 under 35 U.S.C. § 102(b) or that of claims 21 through 26 under 35 U.S.C. § 103.

While it is true that Destouet broadly discloses that any biocompatible triglyceride having an effective atomic number of 5.9 can be used as a filler material in a silicon envelope for breast implants, this patent only specifically describes naturally occurring peanut oil and sunflower seed oil as examples of suitable filler materials. There is nothing in the Destouet patent that specifically recognizes the existence of biocompatible synthetic triglycerides like those prepared by appellants in the claims on appeal or which teaches or suggests the use of biocompatible synthetic triglycerides as a filler material in a surgically implantable prosthesis. Moreover, there is no mention of a method of formulating or preparing the triglycerides disclosed in Destouet, or of any method for preparing synthetic triglycerides at all. Since Destouet does not sufficiently describe or adequately teach a filler material for a surgically implantable prosthesis wherein said filler material comprises a biocompatible

synthetic triglyceride or any method for preparing such

synthetic triglycerides, it follows

that this patent does not provide for that which we have found lacking in the examiner's rejections of claims 18 through 26 above.

To summarize our decision, we note that both the examiner's rejection of claims 18 through 20 under 35 U.S.C. § 102(b) and of claims 21 through 26 under 35 U.S.C. § 103 have not been sustained.

In addition to our determinations above, we find it necessary to REMAND this application to the examiner for a consideration of whether or not a rejection of the claims on appeal would be appropriate under either or both 35 U.S.C. § 112, first paragraph, as being nonenabling, and/or 35 U.S.C. § 112, second paragraph, as being indefinite. Our concern here is that we find no clear basis upon which to select a given viscosity for the filler material based on providing a tactile response that is "substantially the equivalent of the tactile response of a normal human breast." Appellants apparently intend to encompass a viscosity range of greater than about 10,000 cps (claims 23 and 26). However, with regard to the

filler material itself we find no criteria for determining a conversion between tactile response and viscosity. Nor do we have any standards given to determine

exactly what is a tactile response that is substantially the equivalent of the tactile response of a normal human breast, as set forth in claims 21 and 24 on appeal and the claims which depend therefrom. In this regard we note that the tactile response of a normal human breast is itself a variable quantity depending on factors such as the age of a patient, breast size, fitness level of the patient, etc., and this is before we further qualify the tactile response by indicating that it need only be "substantially the equivalent" of the tactile response of a normal human breast. See, for example, Ex parte Brummer,
12 USPQ2d 1653, 1655 (Bd. Pat. App. & Inter. 1989).

In light of the foregoing, the decision of the examiner is reversed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED and REMANDED

ANDREW H. METZ Administrative Patent Judge	)	
CHARLES E. FRANKFORT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
DOUGLAS W. ROBINSON Administrative Patent Judge	)	

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REVERSED AND REMANDED

Prepared: October 4, 2001